

Appl. No. 10/717,310
Amendment transmitted on January 11, 2006
Reply to Office action of November 16, 2005

REMARKS

Claims 1-5 are pending in the present application. By the present amendment, claim 1 has been amended to describe that the vaterite calcium carbonate is present in the form of aggregates. Support for this amendment may be found throughout the application and particularly in paragraph 0025 of the specification.

No new matter has been added.

The Present Invention

The present invention is described in detail on page 3 of the Amendment mailed on September 1, 2005 and the Examiner is directed therein for a detailed description of the invention.

REJECTION UNDER 35 U.S.C. §102

The Examiner has rejected claims 1-3 under 35 U.S.C. §102(b), as being anticipated by, or in the alternative under 35 U.S.C. §103(a) as being obvious, in view of Goffin et al., U.S. Patent No. 5,290,353 ("Goffin").

Applicants have previously argued against the Examiner's rejection in view of Goffin in the Office Action of September 1, 2005 (pages 3 - 7) and presently reiterate those arguments. Additionally, Applicants also make the following arguments and observations.

In the final Office Action of November 16, 2005, the Examiner notes that the present claims do not actually recite that the vaterite calcium carbonate is formed into aggregates. (Page 2).

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By the present amendment, Applicants have amended the present claims to recite that the vaterite calcium carbonate has the form of an aggregate.

Additionally, in the Office Action of November 16, 2005 the Examiner notes that:

Regarding the rejections over 102/103, because the particles of Goffin et al. have the same particle sizes as those claimed, the properties of the particles of Goffin et al. are expected to meet the limitations of claims 4-5. No showing that the particles of Goffin et al. would not meet the claimed limitations has been provided, nor have any reasons for such a difference been given.

Applicants respectfully disagree with the Examiner's analysis because the Examiner has not made an adequate showing to support an assertion of inherency. (Although the Examiner has not specifically used the word "inherency", the Examiner is explicitly invoking the doctrine in order to assert that the subject matter of claims 4-5, specific Brass Einlehner values, are inherently found in the Goffin reference). In order to support an assertion that an element or feature is inherently present in the prior art, the Examiner must show, by objective evidence or cogent technical reasoning, that the missing element necessarily flows from the teachings of the prior art. The fact that an element may be present in the prior art is not sufficient to establish inherency. (M.P.E.P. §2112).

The Examiner has not met this burden. The only showing offered by the Examiner in support of the inherency suggestion is the Examiner's assertion that, "because the particles of Goffin et al. have the same particle sizes as those claimed, the properties of the particles of Goffin et al. are expected to meet the limitations of claims 4-5." Applicants respectfully assert that this showing is not adequate to support the Examiner's inherency

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assertion. As stated above, the M.P.E.P. requires that the missing element necessarily flows from what is taught by the prior art. The Examiner asserts only that the properties of Goffin are "expected" to be identical to the elements recited in claims 4-5. The Examiner has made no showing that the elements of claims 4-5 must necessarily flow from the properties disclosed in Goffin.

Because of these important and substantial differences between Goffin and the subject matter of claims 1-5, these claims meet the requirements for novelty and nonobviousness established by 35 U.S.C. §102 and 35 U.S.C. §103. Reconsideration and withdrawal of the rejection of these claims in view of Goffin is respectfully requested.

CONCLUSION

Reconsideration and withdrawal of the rejection of the claims in view of the remarks provided herein and allowance of the claims being prosecuted are respectfully requested.

Respectfully submitted,

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